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1636

Attorney's Docket No.: 12279-002001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Kim et al.

Art Unit : 1636

Serial No. : 09/785,632

Examiner : T. McKelvey

Filed : February 16, 2001

Title : ZINC FINGER DOMAINS AND METHODS OF IDENTIFYING SAME

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Commissioner for Patents

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RESPONSE TO SECOND RESTRICTION REQUIREMENT

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In the action dated September 26, 2003, the Examiner required three species elections. The Applicants traverse the requirements for the first and second species elections below.

1. The Applicants elect a method in which the hybrid nucleic acid is made by amplifying and joining. Claims 1-35 and 86-98 read on this species.
2. The Applicants elect a method in which the test zinc finger domain is identified in a sequence database and then made. Claims 1-35 and 86-98 read on this species.
3. The Applicants elect a method in which an activation domain is used. Claims 1-35, 86, 88-93, and 95-98 read on this species.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

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37 C.F.R. 1.146 permits elections between "species of [the] invention to which [a] claim will be restricted if no claim to the genus is found allowable." Without further clarification, the Examiner's asserted species – "simply provided" – does not appear to be a proper species of the invention. "Simply provided" and "amplifying and joining" have a genus-species relationship, since "amplifying and joining" is one method of "simply provid[ing]" the hybrid nucleic acids. The alternative interpretation is that "simply provided" means provided by a method other than "amplifying and joining" and that the Examiner finds that such a method is a disclosed species of the invention to which the claims could be restricted. The Applicants request clarification if the Examiner maintains this requirement for election.

Similarly, "simply provided" and "identified in a sequence database and then made" have a genus-species relationship, since identification in a sequence database is one method of "simply provid[ing]" a test zinc finger domain. Again, if "simply provided" means provided by a method other than "identified in a sequence database and then made," then the Applicants understand that the Examiner finds that such a method is a disclosed species of the invention to which the claims could be restricted. The Applicants request clarification if the Examiner maintains this requirement for election.

The Examiner also stated that "claims 1 and 21 are generic." Page 3 of the dated September 26, 2003. As noted above, claims 1-35 and 86-98 are generic with respect to the first and second species elected above. Further, claim 95 is generic with respect to independent claims 1, 16, and 26, and links Groups I and IV. Because the Examiner indicated that claims 1-35 and 86-119 are pending and did not further restrict these claims, the Applicants conclude that claims 1-35 and 86-119 will be examined in this application, subject only to the provisional species elections (of which two are traversed). Note that each of dependent claims 86-94 depends on either claim 1 or claim 21, so claims 86-94 are within Group I and should be examined with that group.

If further discussion is necessary prior to substantive examination, the Examiner is urged to call the undersigned at 617-542-5070.

Applicant : Jin-Soo Kim et al.
Serial No. : 09/785,632
Filed : February 16, 2001
Page : 3 of 3

Attorney's Docket No.: 12279-002001

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Respectfully submitted,

Date:

Oct. 27, 2003

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